

REMARKS

Favorable reconsideration is respectfully requested.

The claims are 1-23. Claims 1 and 2 are currently amended. Claims 3, 4, and 8-23 are withdrawn.

The amendment to claim 1 incorporates the subject matter of claim 2. The amendment to claim 2 is supported on page 7, lines 1-3 of the specification.

No new matter is added.

Applicants elected without traverse Group I, claims 1-7, in the Response filed April 7, 2008. Applicants further elected as a single identity for the variable R the compounds of group (a) as set forth in previous claim 2 (now in claim 1). It was Applicants' understanding at the time that the election of group (a) was a species election. However, it is now evident to Applicants that the further election required on page 2 of the Restriction issued on March 7, 2008 was not a species election, and that the Examiner considers each of the groups (a)-(n) now recited in claim 1 to be directed to separate inventions. Applicants respectfully traverse the further election of a single identity for the variable R as set forth in groups (a)-(n) for the following reasons.

The Restriction Requirement itself indicates that Groups I-III are each single inventions. This is directly stated in the Requirement at page 2, line 7, and at page 2, line 12. It is improper to further restrict what is already conceded as a single invention into further "sub-inventions". The presently claimed compounds are also novel and non-obvious over JP'526 as shown below and therefore provide the special technical feature required for unity of invention.

In addition, the reasons provided by the Examiner for the restriction (on page 3 of the March 7, 2008 Restriction) only address why Groups I-III are separate inventions. The reasons provided by the Examiner do not mention the further election of a single identity for the variable R, or explain why each of groups (a)-(n) are considered to be separate inventions. For the above reasons, the further election of a single identity for the variable R should be considered a species election.

Claim Rejections - 35 U.S.C. §112

Claims 1, 2 and 5-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The current claim amendments address this rejection.

Claim Rejections - 35 U.S.C. §102

Claims 1, 2 and 5 are rejected under 35 U.S.C. §102(b) as being anticipated by JP'526 (JP 08-325526, Machine Translation).

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Liebich et al. (Journal of Chromatography B: Biomedical Sciences and Applications, *Urinary Organic Acid Screening by Solid-phase Microextraction of the Methyl Esters*, 1998, 713(2), pages 427-432).

Applicants respectfully traverse each of these rejections.

The present invention is directed to a compound represented by formula (1), or a salt thereof, as recited in claim 1.

The Examiner asserts that JP'526 discloses in paragraph [0015] the compounds: 2-acryloyloxyethylmalonic acid and 2-methacryloyloxyethylmalonic acid, which correspond to the compounds of claim 1, group (j). However, in fact, the compounds disclosed by JP'526 differ from the compounds of the present invention with respect to the chemical structure of the substituent.

In this regard, Applicants hereto attach for the Examiner's consideration sheets labeled "E0489" and "M1824", which are product code numbers of TGI Co., Ltd., a manufacturer of chemical products. As is evident from the attached sheets, the acryloyloxy group in these compounds refers to an "alkenylcarbonyloxy" group. An "alkenylcarbonyloxy" group is clearly distinguishable from the presently claimed "alkenyloxycarbonyloxy" recited in claim 1, group (j).

Therefore, the presently claimed compounds are novel and non-obvious over JP'526, and further provide a special technical feature as required for unity of invention. All of species (a)-(n) should now be examined and allowed.

The Office Action also asserts that Liebich et al. discloses in Table 1, ethyl malonic acid, which is assumed to easily hydrolyze to malonic acid *in vivo*.

In this regard, Applicants hereto attach the sheet labeled "E0137". The attached "E0137" sheet shows the chemical structure for ethyl malonic acid. As is evident from "E0137", ethyl malonic acid is not an ester. Furthermore, Applicants have incorporated the subject matter of claim 2 into claim 1, and the presently claimed compounds are therefore clearly distinguished from the Liebich et al. disclosure.

Accordingly, the presently claimed compounds are not disclosed or suggested by JP'526 or Liebich et al.

Claims 1, 2 and 5-7 are objected to as containing non-elected subject matter. As discussed above, the election of group (a) of claim 1 should properly be considered a species election. Since the elected species has been demonstrated as allowable, Applicants are now entitled to consideration of additional species as provided by 37 CFR §1.141.

No further issues remaining, allowance of this application is respectfully requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact undersigned at the telephone number below.

Respectfully submitted,

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